

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Reithmeyer et al.) Examiner: Strimbu, Gregory J.
Serial No.: 09/900,442)
Filed: July 6, 2001) Art Unit: 3634
For: ADJUSTABLE DOOR WITH SEALED)
THRESHOLD, HINGE AND FRAME)
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)

REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is being submitted pursuant to 37 C.F.R. 1.192 and is in response both to the Examiner's Answer dated October 10, 2006 and the Examiner's Answer dated November 1, 2006 ("Examiner's Answers").

Response to Examiner's Grounds of Rejection Section (No. 9):

The Examiner's Answers maintain the final rejections but fail to provide a *prima facie* case of obviousness. The Examiner's Answers maintain the contention that combining the four asserted references *Headrick*, *Fehr*, *Hellstrom et al.*, and *Snyder* would have been obvious to one of ordinary skill in the art, but fail to identify the requisite suggestion or motivation to combine these references. The references not only fail to provide motivation to support the Examiner's proposed combination, but even if somehow combined, still fail to teach the claimed invention.

The Examiner admits that the references are not used as the basis for rejection, but only to show features generally available in the art. For example, page 4 of the Examiner's Answers recites:

However, Fehr discloses a weather strip 5 positioned substantially on the bottom 15 of a frame and a top 16 of the frame to seal against a door when the door is in a closed position.

It would have been obvious to one of ordinary skill in the art to provide the snugger strip 31 of Headrick *with a sealing function, as taught by Fehr*, to better seal the slab with respect to the frame.

Additionally, Hellstrom discloses a vertically adjustable hinge.

It would have been obvious to one of ordinary skill in the art to provide Headrick *with a hinge, as taught by Hellstrom*, to provide an easy means for vertically adjusting the height of the door with respect to the frame.

Finally, Snyder discloses the use of a shim 19 for adjusting a horizontal position of hinge 10.

It would have been obvious to one of ordinary skill in the art to provide Headrick *with a shim, as taught by Snyder*, to horizontally adjust the position of the door with respect to the door frame.
(emphasis added)

In lieu of applying the actual teachings of the proposed references, the Examiner improperly contends that one of ordinary skill in the art would be motivated to provide "a sealing function", "a hinge", and "a shim" in the end cap of *Headrick*, as shown in example references *Fehr*, *Hellstrom*, or *Synder*, without identifying or discussing any motivation to make such combinations. The Examiner's Answers then admit in the Response to Arguments section on page 9 that the references fail to provide the requisite motivation:

Although there is no specific teachings in the references themselves, the motivation to combine the teachings of the references is generally available to one having ordinary skill in the art and said motivation for each combination of references has been set forth in the rejection above.

Additionally, the appellant argues the combination of Headrick and Fehr is not possible because the seal of Fehr requires modification to in order to operate with the threshold of Headrick. First, the seal 5 of Fehr is not a mitered seal joined together by fusion welding. Fehr teaches fusion welding the frame rather than the seal. Second, the door sill of Headrick can accommodate a seal. Note that Headrick discloses a seal type device 31 as shown in figures 2 and 3. Therefore, one with ordinary skill in the art would be motivated to provide the snugger strip 31 of Headrick with a sealing function as taught by Fehr to better seal the bottom of the door against wind driven rain. It should be noted that providing seals on a door sill is well known to one of ordinary skill in the art. *The examiner is not stating that the actual seal of Fehr be incorporated into the door sill of Headrick since Fehr is only being used for the basic well known concept of providing a seal on a door sill for sealing against a door.* Therefore, one of ordinary skill in the art need only modify the snugger strip 31 of Headrick such that is seals against the door when the door is in a closed position.

Next, the appellant argues that the examiner referred the appellant to Taber for motivation. The examiner disagrees. *Taber is used only for the teaching of a foamed polymeric seal.* It provides no motivation for the combination of Headrick and Fehr. *(emphasis added)*

What a convenience for the Examiner to assert that a person of ordinary skill in the art is familiar with an element (for example, a shim) and then not take the time to find the claimed shim in the prior art or support for such assertion. This classic scenario of hindsight reasoning, i.e. asserting that modifying a base reference with knowledge in the art would be obvious, is improper. Once Applicant timely traversed the Examiner's proposed reference combination based on motivation of common knowledge in the art, the burden shifted back to the Examiner to provide support in the prior art for the proposed combination, as specified in MPEP 2144.03(C):

If applicant adequately traverses the examiner's assertion of official notice, the examiner *must* provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). *If the examiner is relying on personal knowledge*

to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (**emphasis added**)

In the present application, the Applicant traversed the Examiner's official notice of motivation to combine and further showed that the proposed combination did not teach the pending claims

(Applicants proposed, among other things, that the seal of *Fehr* could not be used on the end cap of *Headrick*¹). The burden thus shifted back to the Examiner to provide support for his assertion of personal knowledge in the art to make the proposed combination. MPEP 2144.03(A) further clarifies that mere reliance on "common knowledge" is never appropriate:

It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience-or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings."). (**emphasis added**)

The Examiner contends that he is not relying upon the actual seal of *Fehr* to be used in the end cap of *Headrick*, but that he is relying on the fact that seals are old technology and that the seal in *Fehr* provides only a basis for teaching that seals exist. The mere existence of a thing in the prior art does not provide the necessary motivation for the Examiner's proposed combination of references. Accordingly, the Examiner has not met his burden of providing a *prima facie* basis

¹ Applicant's have continued to aver that the seal of *Fehr* cannot be combined with the end cap of *Headrick*. *Fehr* provides a form fit, mitered seal joined together by fusion welding and that *Headrick* provides an end cap assembly, which could only incorporate a seal by accommodating the end cap in the bottom of the jamb that protrudes beyond the end of the *Headrick* assembly. The form fitting seal of *Fehr* cannot accommodate the protrusion in *Headrick* without modification, which is not taught or shown in either *Fehr* or *Headrick*. Additionally, the modification required to fit the seal of *Fehr* onto the end cap assembly of *Headrick* would render the seal of *Fehr* unsatisfactory for its intended purpose, which is explicitly prohibited under MPEP § 2143.01. Since the function of *Fehr* is to seal against the sill, combining *Fehr* with *Headrick* would prevent the end cap of *Fehr* from engaging the sill and therefore no seal could be realized. These problems with the proposed combination of *Headrick* and *Fehr* have never been addressed by the Examiner.

for the proposed combination and rejections based on the combination of these references are improper and should be withdrawn.

The failure to identify a suggestion or motivation is understandable because the proposed combination fails to make sense. The snugger strip 31 of Headrick provides a friction fit against the outside edge of the threshold cap 29 to wedge the cap securely within the channel 13. As illustrated in Fig. 3 of Headrick, and related discussions, the bottom of the door slab 54 resides above and is spaced from, the threshold cap when the door is closed. A seal is provided by the flexible door sweep 57 on the bottom of the door. In contrast, the bottom of the door slab in Fehr resides below the seal 5a when the door is closed. Seal 5a performs its sealing function by being wedged and compressed between the inside edge of the sill plate 18 and the outer face of the door when the door is shut (See Fig. 4). There is no motivation to provide Headrick with such a seal because there is no structure in Headrick that projects above the bottom edge of the door between which such a seal might be wedged and compressed. Thus, to provide the snugger strip of Headrick with a sealing function as suggested by the Examiner is senseless because such a seal could not be functional, i.e. it could not form a seal with the door slab. Since there can be no motivation to do a senseless thing, this is one reason the Examiner cannot point to a suggestion or motivation in the art.

CONCLUSION

Claims 1-3 and 8-15 are not rendered obvious by *Headrick* in view of *Fehr, Hellstrom et al. and Snyder*. Claims 4-7 and 40-44 are not rendered obvious by *Headrick* in view of *Fehr, Hellstrom et al., Snyder and Taber*. Claims 47 and 48 are not rendered obvious over *Headrick* in view of *Fehr, Hellstrom et al. and Kurtz*. A *prima facie* case of obviousness has not been established.

For at least the foregoing reasons, the rejections of claims 1-15, 40-44, 47, and 48 by the U.S. Patent and Trademark Office are in error. Reversal of the rejections and allowance of these claims is respectfully requested.

Respectfully submitted,

12/11/06
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